

Appl. No. : 10/017,920
 Filed : December 11, 2001

REMARKS

In response to the Advisory Action mailed December 31, 2003 and the Final Office Action mailed August 1, 2003, Applicant respectfully requests the Examiner to reconsider the above-captioned patent application in view of the foregoing amendments and the following comments. As a result of the amendments listed above, Claims 1-11 and 15-22 remain pending. Claims 12-14 have been cancelled without prejudice or disclaimer, Claims 20-22 have been added, and no claims have been amended.

In the Final Office Action mailed August 1, 2003, the Examiner rejected Claims 1-19 as being obvious over Portney (US 6,197,058) in view of Sarfarazi (US 6,488,708).

Personal Interview

The undersigned Attorney for Applicant thanks Examiner Paul Prebilib for the helpful and courteous interview of November 18, 2003, the substance of which is summarized above.

Rejections for Obviousness

Claims 1-19 stand rejected as obvious over Portney in view of Sarfarazi. For the reasons presented below, Applicant respectfully requests the Examiner to reconsider and withdraw the rejections of Claims 1-19 for obviousness over Portney in view of Sarfarazi.

One of skill in the relevant art would not seek to modify the IOL system 60 disclosed by Portney to relatively move the (larger) primary IOL 62 and (smaller) secondary IOL 64. Portney teaches away from such a modification because his primary IOL 62 is constructed with a larger diameter than the secondary IOL 64 in order to fix the optics together, precisely the opposite of relatively moving them. Portney, Figs. 4, 9a-9d; col. 8:15-25; col. 10:27-64. Portney also discourages any movement of the primary IOL when attaching the secondary IOL: "the present invention comprises an IOL system 60 that includes a primary IOL 62 and a secondary IOL 64 which are configured so the secondary IOL can be readily attached to ... the implanted primary IOL ... without disrupting the position of the primary IOL in the eye." Col. 7: 33-39. Moreover, once Portney's secondary IOL 64 has been attached to the primary IOL 62, further correction of optical power is performed, not by relatively moving the optics or by moving the entire assembly, but by removing the secondary IOL and replacing it, or by stacking additional secondary IOLs on top of the original one. Col. 10:65 - col. 11:22.

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Regarding Claim 15, Applicant further notes that Portney and Sarfarazi, even if combined, do not teach all of the elements of this claim. For example, neither reference discloses a "posterior optic comprising an inner portion and a peripheral portion, said inner portion having a first refractive power, said peripheral portion having a second refractive power which is different from said first refractive power."

For the foregoing reasons, Applicant respectfully submits that Claims 1-19 are in condition for allowance over the prior art of record.

New/Not-Entered Claims 20-22

Applicant respectfully submits that dependent Claims 20-22 (previously submitted but not entered) presented herein are also in condition for allowance over the prior art.

Cancelled Claims 12-14

In view of the addition of Claims 20-22, Applicant has cancelled Claims 12-14 to avoid presenting additional claims without canceling a corresponding number of finally rejected claims (see Advisory Action mailed December 31, 2003). Accordingly, these claims are cancelled only to expedite prosecution of the present application, even though they recite patentable subject matter. Applicant reserves the right to present similar claims in a continuation of the present application or of a related application.

Information Disclosure Statements Filed June 30, 2003 and July 28, 2003

Applicant respectfully requests the Examiner to consider the references cited in the Information Disclosure Statements filed on June 30, 2003 and July 28, 2003, prior to the mailing date of the Final Office Action.

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Conclusion

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, issuance of a Notice of Allowance is most earnestly solicited.

Applicant respectfully traverses each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches. Although cancellations have been made, no acquiescence or estoppel is or should be implied thereby. Rather, the cancellations are made only to expedite prosecution of the present application, and without prejudice to presentation or assertion, in the future, of claims on the subject matter affected thereby. Any arguments in support of patentability and based on a portion of a claim should not be taken as founding patentability solely on the portion in question; rather, it is the overall combination of features recited in a claim which distinguishes it over the prior art.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney, Mark J. Kertz at (949) 721-6318 to resolve such issue(s) promptly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: Jan. 20, 2004

By: Mark J. Kertz
 Mark J. Kertz
 Registration No. 43,711
 Attorney of Record
 Customer No. 20,995
 (949) 760-0404

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